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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/542,990 | 07/21/2005 | Roland C Santa Ana | 4137.3 | 7826 |
| 7590 | 05/26/2010 | | EXAMINER | |
| ROLAND C. SANTA ANA 9010 CHATAM LANE PORT RICHEY, FL 34668 | | | GRANT, ALVIN J | |
| | | ART UNIT | PAPER NUMBER | |
| | | 3723 | | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 05/26/2010 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/542,990 | SANTA ANA, ROLAND C | |
| | Examiner | Art Unit | |
| | ALVIN J. GRANT | 3723 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 February 2010.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 27-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 27-31 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 27-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Te 6,571,666 in view of Kolschner et al. 6,339,974.

Te discloses a hammer for releasably retaining nails of varying sizes, the hammer comprising: a handle (112), a hammerhead (114); a plurality of nail retention grooves of predetermined sizes located on the side surface of the hammerhead (**Fig. 12**) and configured to align corresponding selected nails toward a nail striking orientation; and each of the nail retention groove is dimensioned to releasably accept both a shaft of the nail and a head of the nail, each of the grooves comprising: a partially cylindrical nail body groove portion of substantially uniform radius contiguous with a frustoconical shaped groove for accommodating the nail head; and multiple magnetic cores (**128**) disposed within the hammerhead in magnetic communication with the nail retention groove. Te does not specifically disclose flattened side surfaces. Kolschner et al. teaches that hammerheads may have flattened side surfaces as a matter of design choice. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made Te's hammerhead to have flattened sides as taught by Kolschner et al. as a matter of design choice. Furthermore, it would have been an

obvious matter of design choice to make the different portions of the Te's hammerhead of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

3. **Claims 30 and 31**, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Te and Kotschner et al in view of Hu 6,283,44 and in further view of Caspall 4,726.

Te as modified is described above. The modified Te does not specifically disclose a pair of flared claws with each claw having a nail removal void. Hu discloses a hammer having a pair of flared claws in which the each claw has a nail removal void so as to facilitate the accommodation of nails of different sizes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the modified Te's hammer head to have a pair of flared claws in which the each claw has a nail removal void as taught by Hu so as to facilitate the accommodation of nails of different sizes. Additionally, the modified Te's does not specifically disclose the top portion of the hammer being rounded laterally. Caspall (best shown in Fig. 2) discloses a hammer in which the head is rounded laterally so as to enhance the maneuverability of the hammer. It would have been obvious to one having ordinary skill in the art a the time the invention was made to have made the modified Te's hammer head rounded laterally as taught by Caspall so as to enhance the maneuverability of the hammer.

Response to Arguments

4. Applicant's arguments filed 2/16/10, which references arguments of 6/29/09 responding to the rejection of 10/29/08 and are provided below, have been fully considered but they are not persuasive. It is noted that the Te reference is the base reference in this Office Action while the Kotschner et al.) reference is the teaching reference, as is described above, this is necessitated by Applicant's amendments, but the combination of both references teaches the invention.
5. In response to Applicant's arguments that combination of US Patent 6,339,974 (to Kotschner et al.), with US Patents 6,571,666; 4,723,582; and 6,283,449, to Te, Caspell and Hu respectively does not disclose the claimed invention and there is no motivation to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Kotschner et al. discloses a hammer head having magnets and flattened side surfaces and has a slot for securing nails therein. Te, Caspell and Hu, considered separately, teach the remaining claimed elements as best understood.
Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under

35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396. Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

6. The Examiner appreciates Applicant's demonstration of the apparatus during the Examiner Interview of 12//9/10. The demonstration has not; however, provided information that further distinguish Applicant's apparatus from that of the prior art.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALVIN J. GRANT whose telephone number is (571)272-4484. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail can be reached on (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alvin J Grant/

Examiner, Art Unit 3723